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09/690,549	10/17/2000	Oleg B. Rashkovskiy	BAK.0006US	2613

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EXAMINER	
BROWN, RUEBEN M	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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MAILED

APR 29 2010

DIRECTOR OFFICE
TECHNOLOGY CENTER 2400

In re Application of:
Oleg B. Rashkovskiy
Application Serial No.: 09/690,549
Filed: October 17, 2000
For: **Storing Advertisements**

DECISION
ON PETITION

This is a decision on the petition filed December 10, 2008, which is being treated as a petition under 37 CFR 1.181(a)(1) to invoke the supervisory authority of the Commissioner to review the validity of the Examiner's action in reopening prosecution following the Decision of the Board of Patent Appeals and Interferences of March 07, 2008.

The petition is **denied**.

Background

On March 07, 2008, the Board of Patent Appeals and Interferences rendered a decision reversing the examiner's rejection of claims 45-57 (all pending claims.)

On September 26, 2008, a new non-final Office action was mailed reopening prosecution, rejecting all pending claims as being unpatentable under 35 USC § 103 using combinations of prior art as described below and for lacking a description under 35 USC § 112 first paragraph.

Petitioner inquiries whether prosecution can be reopened on three main issues as follows:
(1) whether prosecution can be reopened on an issue not involving knowledge of un-cited art;
(2) can prosecution be reopened where it is obvious the Examiner did not know of un-cited references, and (3) whether prosecution can be reopened based on references that do not differ significantly from what was already analyzed on appeal.

Authorities

37 CFR § 1.198 states:

When a decision by the Board of Patent Appeals and Interferences on appeal has become final for judicial review, prosecution of the proceeding before the primary examiner will not be reopened or reconsidered by the primary examiner except under the provisions of § 1.114 or § 41.50 of this title without the written authority of the Director, and then only for the consideration of matters not already adjudicated, sufficient cause being shown.

MPEP § 1214.04 states in part:

If the examiner has specific knowledge of the existence of a particular reference or references which indicate nonpatentability of any of the appealed claims as to which the examiner was reversed, he or she should submit the matter to the Technology Center (TC) Director for authorization to reopen prosecution under 37 CFR 1.198 for the purpose of entering the new rejection. See MPEP § 1002.02(c) and MPEP § 1214.07. The TC Director's approval is placed on the action reopening prosecution.

Discussion

The grounds of rejection set forth in the Office action of September 26, 2008 are a 35 USC 112 second paragraph rejection and a 35 USC 103 rejection over a combination of at least U.S. Patent No. 6,434,747 to Khoo et al., U.S. Patent No. 6,446,261 to Rosser and U.S. Patent No. 5,233,423 to Jernigan et al. The Office Action recites that "The examiner has specific knowledge of the existence of a particular reference or references that indicate non-patentability of the appealed claims". For at least claim 47, the particular reference is the Jernigan et al. patent. A review of the application record reveals that an electronic system was accessed. Petitioner is reminded that examiners are required to use electronic systems to retrieve patent documents including references known to examiners. In reference to the first and second issues, Petitioner should note that the examiner's specific knowledge of the existence of particular references and their application in the Office Action is in compliance with MPEP 1214.04.

Petitioner also argued that there is no basis for raising a 35 USC 112 second paragraph rejection "at this stage in the proceedings". Since there are no rules or statutes that bar the examiner from making a 35 USC 112 rejection at this stage of the prosecution, the examiner's actions are appropriate.

As to Petitioner's third issue, the current Office Action identified that the Jernigan reference discloses the claimed "stored advertisements are updated and automatically replaced" issue in a 35 USC 103 rejection with Khoo and Rosser. Therefore, Petitioner's arguments (paragraph bridging pages 2-3 of the petition) against the single Jernigan reference as oppose to the combination is not persuasive.

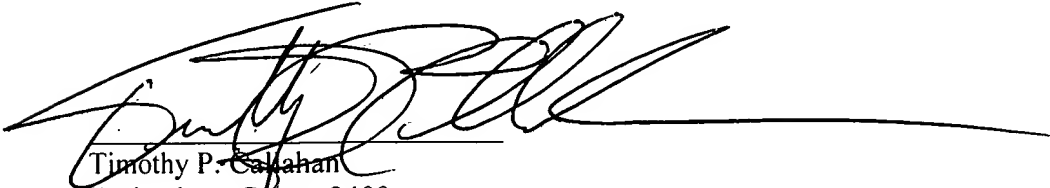
Consequently, the rejections made by the examiner using the combination of Khoo, Rosser and Jernigan cannot be considered previously adjudicated. Additionally, the action of September 26, 2008 re-opening prosecution was approved by the Director (see signature on page 11 of the action) in accordance with rule and procedure discussed *supra*.

Decision

Since the combinations used in the rejections set forth by the examiner were not previously adjudicated and the action was approved by the Director, the petition is **denied**. Any request for reconsideration must be submitted within TWO (2) MONTHS from the mail date of this

decision. No further petition fee is required for the request. Extensions of time under 37 C.F.R. § 1.136(a) are NOT permitted.

The application file will be forwarded to the examiner for treatment of the Appeal Brief filed February 16, 2009.



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